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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,732	08/17/2001	Hubert Haller	2368.119	3602

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PENDORF & CUTLIFF
5111 MEMORIAL HIGHWAY
TAMPA, FL 33634-7356

EXAMINER

KYLE, MICHAEL J

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,732

Applicant(s)

HALLER, HUBERT

Examiner

Michael J Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14 and 16-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 13 and 14 is/are allowed.
6) ☒ Claim(s) 11, 12 and 16-23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 19 is objected to because it is unclear if the second locking system and the locking bolts engaging the boreholes of the housing are the same thing. As best understood by the examiner, they are (i.e., the locking bolts and boreholes are features of the second locking system).
2. Claim 22 is objected to because the second line of the claim recites the limitation “a housing including boreholes”. The first line of the last paragraph of the claim recites “the housing includes first locking boreholes”. It is unclear if the “boreholes” and the “first locking boreholes” are referring to the same feature. As best understood by the examiner, they are. Appropriate correction is required.
3. Claim 22 is objected to because the last paragraph of the claim (beginning “wherein the housing...”) is replete with typographical and grammatical errors. It is unclear which subject matter is being claimed. For example, the first and second lines of this paragraph reads “for locking and receiving case further includes...”. It is unclear what the boreholes lock and receive. Additionally, the claim reads, “locking bolts associated with the case to engage with the locking bolts of the closed case”. As best understood, there is only one pair of locking bolts associated with the case. It is unclear how the locking bolts can engage with the locking bolts, as claimed. It is also unclear if the closed case is the same as the case and the closable case also recited in the claim. This paragraph also includes new language, added by the amendment of February 28, 2005, that is not properly identified as being added to the claim by underlining. Examiner suggests complete revision of the claim for other errors. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 16, 17, 19, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over West (U.S. Patent No. 4,452,390) in view of GB 2039599 (GB '599). With respect to claim 19, West discloses a portable security container comprising a housing (11), a closable case (14) adapted for being received in the housing (11) and comprising a handle (29), The case further includes a first locking system (25, 28) that independently locks the case, and a second locking system (16, 17, 18) to lock the case with the housing. West discloses the case to be locked to the housing by way of the lock (16), blade (17), and slot (18). West does not disclose the housing to include locking boreholes for locking and for receiving locking bolts associated with the case.

6. However, GB '599 teaches a housing (11) that includes locking boreholes (23) for locking and for receiving locking bolts (17) associated with the case (12) in order to securely lock the case in the closed position (Page 1 of specification, lines 26-30) in a housing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the locking boreholes (23) of the housing of GB '599 and the locking bolts (17) of the case (12) of GB '599 in the housing (11) and case (14) of West to more securely lock the case in the housing by supporting the case in the housing with two locking projections, one from each side of the case.

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7. With respect to claim 11, West discloses the first security locking system is a lock with a key (25, 28).

8. With respect to claims 16 and 17, Brush, Jr. et al. (U.S. Patent No. 4,688,493) is cited as an evidentiary reference. Brush, Jr. et al. shows that a fire resistant safe that has steel outer body.

9. With respect to claim 23, the case safe system of West is capable of being secured in closets or bank safes.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over West in view of GB '599 as applied to claim 19 above, and further in view of Johnson et al. (U.S. Patent No. 2,819,692). Neither West nor GB '599 discloses that the locking boreholes are provided with reinforcements. However, Johnson et al. discloses locking boreholes that are provided with reinforcements (45, 46) for the purpose of guiding the locking bars (43, 44, Col. 3, lines 14-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the reinforcements (45, 46) of Johnson et al. in the housing (11) of West to reinforce the locking boreholes.

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over West in view GB '599 as applied to claim 19 above, and further in view of Cantley (U.S. Patent No. 3,970,010). Neither West nor GB '599 discloses a stationary housing to comprise multiple housings connectable with each other.

12. Cantley teaches a stationary housing (walls surrounding compartment 19) to comprise multiple housings (walls surrounding each compartment 19) connectable with each other, in

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order to securely store multiple cases in a single unit. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify West and GB '599 as taught by Cantley in order to securely store multiple cases in a single unit.

13. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over West in view of GB '599, as applied to claim 19 above, and further in view of McConnell et al ("McConnell", U.S. Patent No. 4,786,472). West and GB '599 disclose the case-safe system substantially as claimed, but fail to disclose a soft concealment covering on the case.

14. McConnell teaches a case with a cover made of leather (column 2, line 60, "hard sided leather briefcase"). It is known to make cases from leather, or at least have a leather exterior, for aesthetic purposes. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the case of West and GB '599, as taught by McConnell, such that the cover is made of leather, for aesthetic purposes.

15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai (U.S. Patent No. 5,170,907) in view of Specht (U.S. Patent No. 5,870,910) and GB '599. Sakai discloses a closable case (1) received in a housing (2). The case has a body portion (13) defining a receptacle, and a hinge top flap (14) extending over the receptacle, and a locking system (10a or 10c) associated with the housing (2). Sakai fails to disclose a handle or the housing to include first locking boreholes for locking and receiving locking bolts associated with the case.

16. Specht teaches a case (14) with a handle (110) with anchoring means (108) at each end securing the handle to a top flap (56) of the case. Including a handle on a case allows the case to

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be easily transported. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sakai, as taught by Specht, to include a handle, to allow for easy transport of Sakai's case (1).

17. GB '599 teaches a housing (11) that includes locking boreholes (23) for locking and for receiving locking bolts (17) associated with the case (12) in order to securely lock the case in the closed position (Page 1 of specification, lines 26-30) in a housing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the locking boreholes (23) of the housing of GB '599 and the locking bolts (17) of the case (12) of GB '599 in the housing (2) and case (1) of Sakai to more securely lock the case in the housing by supporting the case in the housing with two locking projections, one from each side of the case. The combination would result locking members 15 and 17 of GB '599 being implemented into the case of Sakai, and boreholes 23 being implemented into the housing of Sakai.

Allowable Subject Matter

18. Claims 13 and 14 are allowed.

Response to Arguments

19. Applicant's arguments with respect to claims 11, 12, and 16-21 have been considered but are moot in view of the new ground(s) of rejection. Independent claim 19, from which claims 11, 12, 16-18, 20, and 21 depend, is now rejected by the combination of West of GB '599. The new grounds of rejection were necessitated by applicant's amendment to claim 19. Specifically,

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the claim, as amended, now requires boreholes and locking bolts, which necessitated the new grounds of rejection.

20. With respect to claim 22, applicant states that the arguments with regard to the Sakai reference “can be found in the previous paragraph”. It is unclear which paragraph applicant is referring, as the “previous paragraph” does not address any arguments. Additionally, because applicant’s arguments with respect to Sakai fail to specifically address limitations of claim 22, these arguments cannot be addressed, as they are unclear as to which parts of the examiner’s rejection based on Sakai are traversed, with respect to claim 22. Applicant’s arguments, with respect to the Sakai reference, and claim 22, fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

21. With respect to claim 22, applicant argues there is no motivation to combine Specht with Sakai, such that Sakai includes a handle. Examiner respectfully disagrees. The use of handles on cases is old and well known in the art. Placing a handle on a case does not patentably distinguish the case of the instant application from the prior art. The use of handles is known to assist in transporting a case. Applicant further argues a number of limitations that Specht allegedly fails to teach. Examiner notes that Specht does teach a case having a handle, as discussed above. The second locking system with boreholes, and locking bolts to engage the boreholes is taught by GB ‘599, as discussed in the body of the rejection.

22. Applicant appears to argue that GB ‘599 is non-analogous art in the first paragraph of page 15 of the response filed February 28, 2005. Examiner respectfully disagrees. It has been held that a prior art reference must either be in the field of applicant’s endeavor or, if not, then be

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reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, GB '599 is both. The drawer of GB '599 is similar to the claimed case as it used to hold objects, and is secured in a housing. The present application is concerned with securing a case in a location, to prevent removal of the case. The drawer of GB '599 is concerned with the identical problem.

23. Applicant argues that none of the references taken alone or in combination show a first and second locking system being independent from each other. Examiner notes this argument appears to be narrower than claim 22, as claim 22 does not recites the locking systems being "independent" from each other.

24. Applicant argues the prior art fails to teach a housing with boreholes, a locking system to lock the case within the housing, and a case including locking bolts to engage with the boreholes of the housing. Examiner disagrees. GB '599 expressly shows all of these features, as discussed in the body of the rejection.

25. Applicant appears to argue the combination of Sakai with GB '599 teaches away, and destroys Sakai's invention. Applicant argues that Sakai's case should not have projecting surfaces, and that modifying as taught by GB '599 would lead to projecting surfaces. Examiner notes that when the drawer of GB '599 is in the unlocked state, the locking bolts do not project from the drawer. They only project in the locked state, similar to the pawl of Sakai which projects from the case in the locked state. Therefore, because Sakai also teaches a projection from an outer surface, the combination with GB '599 does not teach away. Additionally, the combination would not render Sakai inoperable. Both Sakai and GB '599 are actuated by a

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rotational key lock. Modifying the actual locking components of Sakai as taught by GB '599 will not render Sakai's invention inoperable. It appears as though pivotably attaching the locking bolts on pawls 10a and 10b of Sakai would still permit functioning of Sakai's invention.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

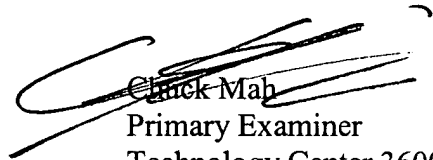
28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk


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